REMARKS

In the Office Action dated September 18, 2009, the Office imposed a restriction requirement under 35 U.S.C. §121 against claims 1-20 and surprisingly determined that among these mere 20 claims there was a total of forty-eight (48) different and patently distinct invention. The restriction of the claims is as follows:

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I-IV. Claims 1, 3 and 6, drawn to a nucleic acid, complement or variant of the nucleotide sequence encoding Futrin 1, 2, 3 *or* 4, classified in class 435, subclass 320.1.

V-VIII. Claims 1 and 6, drawn to Futrin 1, 2, 3 *or* 4 polypeptide or a fragment thereof, classified in class 530, subclass 350.

IX-XII. Claims 1, 2 and 4-6, drawn to a ligand for Futrin 1, 2, 3 *or* 4, classified in class 530, subclass 387.9.

XIII-XVI. Claims 7, 8, 9 and 18, drawn to a method for diagnosing diseases using a nucleic acid, complement or variant of the nucleotide sequence encoding Futrin 1, 2, 3 *or* 4 and/or Futrin 1, 2, 3 *or* 4 or a fragment thereof and/or a ligand for Futrin 1, 2, 3 *or* 4, classified in class 435, subclass 4.

XVII-XX. Claim 10, drawn to a method of identifying a binding partner for a Futrin 1, 2, 3 *or* 4 polypeptide, classified in class 435, subclass 8.

XXI-XXIV. Claim 11, drawn to a method of identifying activators/agonists or inhibitors/antagonists for a Futrin 1, 2, 3 *or* 4 polypeptide, classified in class 435, subclass i.e. 7.71.

XXV-XVIII. Claim 12, drawn to a method of obtaining and identifying drug candidates for diseases associated with aberrant expression of Futrin 1, 2, 3 *or* 4 by detecting presence or absence of a single or increase of a signal, classified in class 435, subclass 7.7.

XXIX-XXXII.Claim 13, drawn to activators/agonists or inhibitors/antagonists for Futrin 1, 2, 3 *or* 4 polypeptide, classified in class 514, subclass 1.

XXXIII-XXXVI. Claim 14 and 15, drawn to a pharmaceutical composition that modulates expression of Futrin 1, 2, 3 *or* 4, classified in class 435, subclass 7.1.

XXXVII-XL. Claim 19 and 20, drawn to a method of preparing a pharmaceutical composition comprising Futrin 1, 2, 3 *or* 4 nucleic acid, classified in class 544, subclass 44.

XLI-XLIV. Claim 19 and 20, drawn to a method of preparing a pharmaceutical composition comprising Futrin 1, 2, 3 *or* 4 polypeptide, classified in class 544, subclass 2.

XLV-XLVIII. Claim 19 and 20, drawn to a method of preparing a pharmaceutical composition comprising Futrin 1, 2, 3 *or* 4 binding partner, classified in class 544, subclass 1.

Applicants believe that it would be a great economy of cost and effort on the part of the Office, to examining Group 18, 22 and 26 because all of these groups are related to determining a binding ligand or partner that binds to the Futrin 2 polypeptide.

The Office should be aware that the description requirements of 35 U.S.C. §112 compel disclosure of different aspects of the invention in the one application. More important, the courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein. The CCPA has observed:

> We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved. *In re Kuehl,* 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Office held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit **has declined to hold that §121 protects a patentee from an allegation of same-invention double patenting**, *Studiengesellschaft Kohle mbH v. Northern Petrochemical Co.,* 784 F.2d 351, 355, 228 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in *Gerber Garment Technology Inc. v. Lectra Systems Inc.*, 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990) that court held that §**121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement.** Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of patent on the divisional application. All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee's rights and to serve the public's interest, the Office should not require restriction in cases such as the present application wherein various aspects of a unitary invention are claimed.

Still further, applicants are well aware that the Office can issue such a restriction requirement which forces the filing and incredible costs of filing multiple divisional applications only to have the Office rescind the restriction requirement a few years later when all the additional divisional applications are being allowed and it is finally recognized that the original restriction requirement was unnecessary. Thus applicants are forced to file terminal disclaimers but only after spending thousands of dollars because the Office imposed an unnecessary restriction requirement. As such, applicants request reconsideration.

In the event the requirement is adhered to, applicants provisionally elect with traverse, the invention of Group XVIII (18) drawn to claim 10 (futrin 2 polypeptide), for further examination on the merits. Applicants have added new claim 21 to 29, all of which fit within the scope of Group XVIII.

Petition for Extension and Fees Payable

Applicants petition for a two month extension to extend the response due date of October 18, 2009 to December 18, 2009 and the fee of $245.00 is being paid herewith by electronic transfer. Further, applicants added one additional depended claim with a fee of $26.00. If any additional fee is found due for entry of this amendment, the Commissioner is authorized to charge such fee to Deposit Account No. 13-4365 of Moore & Van Allen.

It is requested that examination and prosecution of this application proceed on the basis of the amended pending claims in the application.

Respectfully submitted,

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